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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/055,902 | 01/28/2002 | Shinichi Koyama | 03500.016144 | 2051 |
| 5514 | 7590 | 07/28/2005 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO | | | VIEAUX, GARY | |
| 30 ROCKEFELLER PLAZA | | | ART UNIT | |
| NEW YORK, NY 10112 | | | PAPER NUMBER | |
| | | | 2612 | |
| DATE MAILED: 07/28/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,902

Applicant(s)

KOYAMA, SHINICHI

Examiner

Gary C. Vieaux

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

The Amendment filed May 16, 2005 has been received and made of record. In response to the first Office Action, the title, the specification, and claims 1-8 have been
5 amended. Claims 9-12 have been added.

Response to Amendment

In response to Applicant's amended specification, the Applicant has requested replacement of paragraphs starting at pages 5 and 7, respectively, in order to correct
10 minor typographical informalities. These paragraphs have been found to correspond to the specification submitted on January 28, 2002, at page 7 lines 13-19 and page 9 lines 10-13, respectively.

In response to Applicant's amended title, the amended title is not found to be clearly indicative of the invention to which the claims are directed. A new title is
15 required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: IMAGE PICKUP APPARATUS AND METHOD
FOR THE OUTPUT OF AV DATA AND THE CONTROL OF THE OUTPUT OF AV
DATA TO AN EXTERNAL STORAGE DEVICE.

The disclosure was objected to in the Office Action of January 14, 2005 because
20 of the following informalities: Line 14 of page 2 includes "starting" misspelled as "staring". This objection was not cured by amendment, and therefore, continues to be maintained. Appropriate correction is required.

In response to Applicant's amended claims 1, 3 and 7, the amendments are found to correct the respective informalities, and therefore, the objections to claims 1, 3, and 7 are withdrawn.

In further response to Applicant's amended claims 1-8, the respective
5 amendments are found to eliminate indefiniteness within the scope of 35 U.S.C. 112 second paragraph, and therefore the 35 U.S.C. 112 second paragraph rejection of claims 1-8 is hereby withdrawn.

Response to Arguments

10 Applicant's arguments with respect to the 35 U.S.C. 102(e) rejections as being anticipated by Ito et al. (US 6,453,071) have been fully considered and are persuasive. The rejections of claims 1-8, as being anticipated by Ito et al., have been withdrawn.

Applicant's arguments with respect to the 35 U.S.C. 103(a) rejections as being unpatentable over Saito et al. (US 6,184,922) in view of Greening et al. (US 5,701,912)
15 have been fully considered but they are not persuasive.

Regarding amended claim 1, Applicant contends that neither Saito et al.'s outputting of a digitized image pickup signal to an external device which is connected to a recording device in any manner teaches or suggests that image data to be recorded on a recording medium by a recording unit is output by a communication unit which is
20 controlled by start and stop instructions as in Claims 1 and 5 (Remarks, p.13 lines 21-25), nor the combination of Saito et al. and Greening et al. suggests the feature of a communication unit of image capture apparatus outputting image and sound data that is

to be recorded on a recording medium by a recording unit combined with the feature of the communication unit being controlled to start output of the image and sound data that is to be recorded on the recording medium in response to a start instruction and to stop the output of the image and sound data in response to a stop instruction (Remarks, p. 14

5 lines 2-10.) The Examiner respectfully disagrees.

Claim 1, as currently written, provides for a recording unit adapted to record image and sound data on a recording medium, and a communication unit being capable of connecting with an external storage device and outputting the image and sound data that is to be recorded on the recording medium, wherein said image capture apparatus
10 is capable of controlling said communication unit to start an output of the image and sound data that is to be recorded on the recording medium in response to an instruction of starting recording, and to stop an output of the image and sound data that is to be recorded in response to an instruction of a stopping recording.

Saito provides a teaching of a recording unit adapted to record on a recording
15 medium (fig. 1 indicator 97), as well as a communication unit (fig. 1 indicator 6) capable of connecting with an external storage device (fig. 1 indicator 10) and outputting the data that is to be recorded on the recording medium (fig. 1, in which data is output from indicator 6 to both indicators 10 and 97.) Saito also provides a teaching wherein said image capture apparatus (fig. 1 indicator 3) is capable of controlling said communication
20 unit to start an output of the image and sound data that is to be recorded on the recording medium in response to an instruction of starting recording, and to stop an output of the image and sound data that is to be recorded in response to an instruction

of a stopping recording (by way of the release switch 48, Abstract and col. 12 lines 25-32.) However, Saito is not found to include sound data.

Nevertheless, Greening, which deals with matters similar to Saito, is provided to teach the inclusion of microphones within endoscopes (col. 3 line 63 – col. 4 line 7.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include sound data as taught by Greening, with the image capture apparatus as taught by Saito and being operated on in a similar manner to that of the image data as taught by Saito. One of ordinary skill in the art at the time of the invention would have been motivated to include sound data with the image data of an endoscope in order to simulate both eyes and ears inside of a body cavity.

Because Saito in view of Greening can be interpreted to read on claim 1, as it is currently written, the Examiner stands behind the 103(a) rejection to claim 1.

Regarding claim 5, although the wording is different, the material is considered substantively equivalent to claim 1, as discussed above, and therefore the Examiner relies on the same conclusions to amended claim 5, as it is currently written, and stands behind the 103(a) rejection to claim 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2612

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7/24/05

¹⁻¹²
Claims ~~1-8~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 6,184,922) in view of Greening et al. (US 5,701,912.)

Regarding claim 1, Saito provides a teaching of a recording unit adapted to record on a recording medium (fig. 1 indicator 97), as well as a communication unit (fig. 1 indicator 6) capable of connecting with an external storage device (fig. 1 indicator 10) and outputting the data that is to be recorded on the recording medium (fig. 1, in which data is output from indicator 6 to both indicators 10 and 97.) Saito also provides a teaching wherein said image capture apparatus (fig. 1 indicator 3) is capable of controlling said communication unit to start an output of the image and sound data that is to be recorded on the recording medium in response to an instruction of starting recording, and to stop an output of the image and sound data that is to be recorded in response to an instruction of a stopping recording (by way of the release switch 48, Abstract and col. 12 lines 25-32.) However, Saito is not found to include sound data.

Nevertheless, Greening, which deals with matters similar to Saito, is provided to teach the inclusion of microphones within endoscopes (col. 3 line 63 – col. 4 line 7.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include sound data as taught by Greening, with the image capture apparatus as taught by Saito and being operated on in a similar manner to that of the image data as taught by Saito. One of ordinary skill in the art at the time of the invention would have been motivated to include sound data with the image data of an endoscope in order to simulate both eyes and ears inside of a body cavity.

Regarding claim 2, Saito and Greening teach all the limitations of claim 2 (see the 103(a) rejection to claim 1 supra) except for explicitly teaching an image capture apparatus wherein the image capture apparatus is capable of controlling said communication unit to continue an output of the image and sound data that is to be recorded on the recording medium until the instruction stopping recording is inputted, irrespective of whether or not said recording unit can normally record the image and sound data on the recording medium.

Nevertheless, it would have been obvious to one of ordinary skill in the art at the time of the invention for the communication unit to continue to output the image and sound data that is to be recorded on the recording medium until the instruction stopping recording is inputted, irrespective of whether or not said recording unit can normally record the image and sound data on the recording medium, so that the image and sound data outputted may still be observed by a viewing monitor (e.g., fig. 1 indicator 7.) It is further noted that the image data outputted to the monitor is the same image and sound data that would be recorded.

Regarding claim 3, Saito and Greening teach all the limitations of claim 3 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus wherein said communication unit outputs the image and sound data by using an isochronous transfer conformed to IEE1394-1995 standards ('922 - col. 12 lines 48-50.)

Regarding claim 4, Saito and Greening teach all the limitations of claim 4 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus wherein the apparatus is a camera-integrated digital video recorder ('922 - col. 4 lines 37-44, in

which the camera, indicator 4 of fig. 1, can be integrated with a DVD-R or DVD-RAM drive.)

Regarding claim 9, Saito and Greening teach all the limitations of claim 9 (see the 103(a) rejection to claim 1 supra) including teaching an apparatus further comprising
5 an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium ('922 - fig.1 indicator 4), and a sound data generating unit ('912 - 3 line 63 – col. 4 line 7) adapted to collect a sound and generate the sound data that is to be recorded on the recording medium.

Regarding claim 10, Saito and Greening teach all the limitations of claim 9 (see
10 the 103(a) rejection to claim 2 supra) including teaching an apparatus further comprising an image data generating unit adapted to capture an image and generate the image data that is to be recorded on the recording medium ('922 - fig.1 indicator 4), and a sound data generating unit ('912 - 3 line 63 – col. 4 line 7) adapted to collect a sound and generate the sound data that is to be recorded on the recording medium.

15 Regarding claims 5-8, 11 and 12, although the wording is different, the material is considered substantively equivalent to claims 1- 4, 9 and 10, respectively, as discussed above.

Conclusion

20 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact

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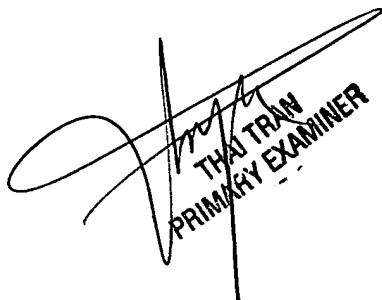
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Thai Q. Tran, can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned will be 703-872-9306 until September 15, 2005, and beginning July 15, 2005 will become 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C. Vieaux
Examiner
Art Unit 2612

10 Gcv2



THAI TRAN
PRIMARY EXAMINER